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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,502	02/07/2002	Gerald A. Reine	112025-0035C2	4633
24267	7590	11/08/2005	EXAMINER	
CESARI AND MCKENNA, LLP 88 BLACK FALCON AVENUE BOSTON, MA 02210			KHOO, FOONG LIN	
			ART UNIT	PAPER NUMBER
			2664	

DATE MAILED: 11/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/071,502	Applicant(s) REINE ET AL.	
	Examiner F. Lin Khoo	Art Unit 2664	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/07/02</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-5 and 6-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 and 6-10 of U.S. Patent No. 6,023,473. Although the conflicting claims are not identical, they are not patentably distinct from each other because of reasons set below:

With respect to claim 1, the corresponding patent claim 1 claims an application programming interface comprising: a host interface which transfers signals to and from the host computer driver; a modem interface which transfers signals to and from the host interface and which transfers commands and data associated with analog type telephone calls to and from a modem processor in the telephone data processing system, the modem processor processing analog type telephone calls; and an ISDN

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interface which transfers signals to and from the host interface and which transfers commands and data associated with ISDN telephone calls to and from an ISDN processor in the telephone data processing system, the ISDN processor processing ISDN telephone calls (see U.S. Patent No. 6,023,473, claim 1, col. 20, lines 38-57). However, the patent claim 1 does not claim a host processor configured to provide the application programming interface. Since an application programming interface is implemented as a software application intended to run on any computer processing system, it would have been obvious to one of ordinary skill in the art at the time of the invention to use a processor within any computer such as a host computer to run the application programming interface.

With respect to claims 2-5, the corresponding patent claims 2-5 are identical (see U.S. Patent No. 6,023,473, claims 2-5, col. 20, line 58 through col. 21, line 6).

With respect to claim 6, the corresponding patent claim 6 claims a method comprising: providing a host interface which transfers signals to and from the host computer driver; providing a modem interface which transfers signals to and from the host interface and that transfers commands and data associated with analog type telephone calls to and from a modem processor in the telephone data processing system, the modem processor processing analog type telephone calls; and providing an ISDN interface which transfers signals to and from the host interface and that transfers commands and data associated with ISDN telephone calls to and from an ISDN

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processor in the telephone data processing system, the ISDN processor processing ISDN telephone calls (see U.S. Patent No. 6,023,473, claim 6, col. 21, line 7 through col. 22, line 4). However, the patent claim 6 does not claim an apparatus implementing an application programming interface which performs the method of providing communication between a host computer driver and a telephone data processing system. Since an application programming interface is implemented as software application intended to run on any computer processing system, it would have been obvious to one of ordinary skill in the art at the time of the invention to implement the method using an apparatus such as a host computer with an application programming interface.

With respect to claims 7, 9 and 10, the corresponding patent claims 7, 9 and 10 are identical (see U.S. Patent No. 6,023,473, claims 7, 9, 10, col. 20, line 58 through col. 21, line 6).

With respect to claim 8, the corresponding patent claim 8 (dependent on claim 6) claims the modem interface, transferring commands and data to and from the modem processor to process multiple simultaneous analog type telephone calls (see U.S. Patent No. 6,023,473, claim 8, col. 22, lines 9-12). However, the patent claim 8 does not claim an apparatus wherein the ISDN interface means transfers commands and data to and from the ISDN processor to process multiple simultaneous ISDN telephone calls. Since ISDN allows user to transmit data with voice simultaneously it would have

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been obvious to one of ordinary skill in the art at the time of the invention to use an ISDN interface similar to the modem interface to transfer commands and data to and from the ISDN processor to process multiple simultaneous ISDN telephone calls that has voice and data.

3. Claims 1-5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,347,093. Although the conflicting claims are not identical, they are not patentably distinct from each other because of reasons set below:

With respect to claim 1, the corresponding patent claim 1 claims a storage medium containing instructions readable by a computer to configure the computer to provide an application programming interface for providing an interface between a host computer driver and a telephone data processing system, said telephone data processing system being capable of processing analog type telephone calls and ISDN telephone calls, said application programming interface comprising: a host interface that transfers signals to and from the host computer driver; a modem interface that transfers signals to and from the host interface and which transfers commands and data associated with analog type telephone calls to and from a modem processor in the telephone data processing system, the modem processor processing analog type telephone calls; and an ISDN interface that transfers signals to and from the host

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interface and which transfers commands and data associated with ISDN telephone calls to and from an ISDN processor in the telephone data processing system, the ISDN processor processing ISDN telephone calls (see U.S. Patent No. 6,347,093, claim 1, col. 13, line 64 through cols 14, line 61). However, the patent claims 1 does not claim a host processor configured to provide the application programming interface. Since an application programming interface is implemented as a software application, it would have been obvious to one of ordinary skill in the art at the time of the invention to have the application programming interface contained in a storage medium for execution by a processor within any computer such as a host computer.

With respect to claims 2-5, the corresponding patent claims 2-5 are identical (see U.S. Patent No. 6,347,093, claims 2-5, col. 14, line 62 through col. 16, line 3).

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,483,530 to Davis et al. relates to an ISDN terminal equipment which will maintain connectivity with existing analog modems by setting up a voice-grade connection to existing analog modems and using the power of a digital signal

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processor DSP to generate the digital equivalent of the analog modem signals for transmission on an ISDN "B" channel.

U.S. Patent No. 5,796,958 to Koenzen relates to making a passive ISDN adapter card compatible with a modem connected to a serial port without the need to make any use of the INT 14 H interface for the evaluation process.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. Lin Khoo whose telephone number is 571-272-5508. The examiner can normally be reached on flex time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on 571-272-3134. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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SUPERVISORY PATENT EXAMINER